

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Applicant: Albert Andrew Murrer III
Title: TRANSPORT CONTAINER
FOR HAZARDOUS MATERIAL
Appl. No.: 10/629,322
Filing Date: 7/28/2003
Examiner: Grosso, Harry A.
Art Unit: 3781
Confirmation Number: 6587

REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Sir:

Applicant (hereinafter "Appellant") submits this Reply Brief in response to the Examiner's Answer dated March 29, 2007. No fee is believed to be due in connection with this submission. However, if a fee is deemed due, the Commissioner is authorized to charge such fee to Deposit Account No. 50-0872.

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STATUS OF CLAIMS

Claims 1-10 and 12-25 are pending in the application.

Claim 11 has been cancelled.

Claims 1-5 and 20-24 are withdrawn.

Claims 6-10, 12-19 and 25 are the subject of this appeal.

The pending claims are presented in Appendix A of Appellant's Appeal Brief of January 4, 2007.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejection of claims 6 and 12-16 under 35 U.S.C. § 103(a), as being obvious over Redzisz *et al.*, U.S. Patent Publication No. 2003/0136702 (hereinafter “Redzisz”), in view of Zeddies, U.S. Patent No. 6,336,342 (hereinafter “Zeddies”).

2. The rejection of claims 7 and 8 under 35 U.S.C. § 103(a), as being obvious over Redzisz and Zeddies in view of Tattam, U.S. Patent No. 6,609,628 (hereinafter “Tattam”).

3. The rejection of claim 9 under 35 U.S.C. § 103(a) as being obvious over Redzisz and Zeddies as applied to claim 6, in view of Boyd-Moss *et al.*, U.S. Patent No. 6,631,801 (hereinafter “Boyd-Moss”).

4. The rejection of claim 10 under 35 U.S.C. § 103(a), as being obvious over Redzisz and Zeddies in view of Kalal, U.S. Patent Publication No. 2003/0106895 (hereinafter “Kalal”).

5. The rejection of claim 16 under 35 U.S.C. § 103(a), as being obvious over Redzisz and Zeddies in view of Reichert, U.S. Patent No. 4,865,899 (hereinafter “Reichert”).

6. The rejection of claims 17-19 under 35 U.S.C. § 103(a), as being obvious over Redzisz and Zeddies in view of Travis, U.S. Patent No. 4,485,159 (hereinafter “Travis”).

7. The rejection of claim 25 under 35 U.S.C. § 103(a), as being obvious over Redzisz and Zeddies, in view of McHutchison (hereinafter “McHutchison”).

Only rejections 1, 5 and 7 are addressed herein. Appellant maintains that all rejections are improper and are traversed for the reasons of record and specifically set forth in Appellant’s Appeal Brief of January 4, 2007.

ARGUMENT

I. The legal standard for obviousness.

In order to make a *prima facie* case of obviousness, the Examiner must demonstrate that the prior art (i) teaches or suggests every claim limitation, (ii) provides a motivation to combine (or modify) the teachings of the selected references, and (iii) provides a reasonable expectation of success. In re Vaeck, 947 F.3d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. This is the “TSM” test for obviousness which was recently affirmed by the Supreme Court. KSR Int’l Co. v. Teleflex Inc., No. 04-1350, 550 U.S. ____, slip op. at 15 (2007). In explicating the correct standard for this test, the KSR Court reaffirmed previous holdings that an invention “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Id. at 14, see also, In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998). On the requirement to demonstrate a motivation to combine elements, the Court mandates that “the analysis should be made explicit”. KSR, slip op. at 14. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

II. Rejection of claims 6 and 12-16 under 35 U.S.C. § 103(a)

The Examiner characterizes Redzisz as disclosing a container with a collapsible soft-sided outer shell, a plurality of vertical walls and a bottom integrally formed, an inner layer of watertight material, and a lid secured to the sidewalls. Examiner’s Answer at page 4. The Examiner acknowledges that Redzisz does not disclose the use of an inner rigid frame—a requirement of Appellant’s claim 6. Id. To remedy this deficiency, the Examiner turns to Zeddies which discloses a collapsible rigid inner frame for use in a collapsible cooling pack. The Examiner, without regard for the compatibility of the two elements in the cited art, alleges that it

would have been obvious to combine these two elements to arrive at Appellant's invention. Appellant strongly disagrees with this rejection.

In applying this rejection, the Examiner has failed to articulate reasoning, with some rational underpinning, why Appellant's claimed invention is obvious. Specifically, the Examiner has failed to satisfactorily answer the critical question regarding the motivation to combine: Why would the artisan combine the inner frame of Zeddies with the container of Redzisz?

The Examiner argues that "[t]here is no inner frame structure in Redzisz to prevent the container from being moved [sic] from the open configuration toward the collapsed configuration, either on purpose or by accident, whether the case is empty or has some contents, if collapsing forces are applied to the end panels or the bottom panel." Id. at page 9, ¶ 1. Furthermore, the Examiner alleges that there is nothing in the Redzisz container that prevents a partial or complete collapse when such occurrence is undesirable. The Examiner's characterization of the Redzisz is demonstrably wrong.

The Redzisz container does not have an internal frame because one is not needed. Redzisz provides a container "that is foldable yet maintains its structural integrity and shape when the case is fully opened." Redzisz et al. at ¶ 10 and Figure 2. The structural rigidity of the Redzisz container is provided by the materials and its construction. The bottom of the container comprises two rigid or semi-rigid plates (elements 76 and 78 in Figure 11) and a stitched seam (element 70) at the boundary between the back side and the bottom side. Id. at ¶¶ 33-34. The container is constructed to have certain properties which maintain its shape in the open position and, as demonstrated in Figure 6 of Redzisz, clasps must be used to hold the container in folded closed position. Thus, the Examiner's allegation that there is nothing in the Redzisz container to prevent a partial or complete collapse flies in the face of the Redzisz teachings.

The answer to the question "Why one would add an inner frame to the Redzisz container?" is: One would not. One would not add an inner frame because the Redzisz container is structurally sound in its open configuration—as specifically engineered by Redzisz.

Thus, in applying this rejection the Examiner has failed to identify a valid motivation to combine the teachings of Redzisz and Zeddies. The Examiner has merely identified the various elements of Appellant's claimed invention in the prior art. This is not enough.

Because motivation to combine the primary and secondary reference is lacking, Appellant respectfully requests that the pending obviousness rejection of claim 6 and 12-16 be withdrawn or reversed.

III. Rejection of claim 16 under 35 U.S.C. § 103(a)

Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for claim 16 over Redzisz and Zeddies, in view of Reichert because Reichert is non-analogous art and the Examiner has failed to demonstrate otherwise.

“[I]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); MPEP § 2141.01(a),

Reichert is concerned with a containment structure “for preventing environmental contamination from any leakage of an associated storage tank, piping system, or the like.” Reichert at col. 2, lines 17. In exemplifying the field of his invention, Reichert refers to “bulk storage tanks” including underground and aboveground tanks. Reichert at col. 1, lines 6-18, col. 3, lines 59-64, and Figure 1-2. Furthermore, a preferred method for assembly of the Reichert storage tanks includes radio frequency or sonic welding. Reichert at col. 2, lines 47-52.

It is entirely unclear what relevance the bulk storage containers of Reichert has to Appellants claimed invention of a man-portable, collapsible container. In the Examiner's

Answer, the Examiner alleges merely a conclusory statement that both Appellant and Reichert involve the storage and transport of hazardous material which, while literally true, fails to account for the vast differences in scale, construction, and implementation. Thus, Appellant maintains that Reichert is non-analogous art which does not commit itself to the attention of the skilled artisan in the field relevant to Appellant's invention. Accordingly, any rejection over Reichert is improper and should be reversed and withdrawn.

IV. Rejection of claims 17-19 under 35 U.S.C. § 103(a)

Appellant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) for claims 17-19 over Redzisz and Zeddies, in view of Travis.

Here again, the Examiner has performed an improper analysis with respect to the motivation to combine prior art elements. The Examiner has confused the issue of what an artisan could do (i.e., physical combinability) with what an artisan would do (i.e., has a motivation to physically combine). In asserting this rejection, the Examiner alleges that the artisan could place the foldable container of Travis inside the container of Redzisz. In doing so, the container of Travis would act as a collapsible internal frame. Thus, the Examiner is basing this rejection on the notion of placing a box inside another box.

The Examiner has failed to articulate logical reasoning as to why an artisan would make such a combination. Travis provides one type of foldable container; and Redzisz another. An artisan would naturally use either the Travis container or the Redzisz container depending upon the particular application. Other than his own personal opinion and hindsight reconstruction using Appellants' disclosure (which are insufficient grounds to sustain an obviousness rejection), the Examiner has demonstrated no reason or motivation to make the alleged combination of Travis and Redzisz. Accordingly, the rejection of claim 16 as being obvious over Redzisz and Zeddies in view of Travis fails and should be withdrawn or reversed.

V. Rejections not addressed herein

For all rejections not specifically addressed herein, Appellant maintains that the rejections are improper and are traversed for the reasons of record and specifically set forth in Appellants' Appeal Brief of January 4, 2007.

CONCLUSION

For the reasons discussed above, Appellant respectfully submits that claims 6-10, 12-19 and 25 are in condition for allowance, and respectfully request that the rejections be withdrawn or reversed, and that the claims be allowed to issue.

Respectfully submitted,

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